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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,542	05/22/2001	Robert Alan Reeves	STEV-109	1268

7590

09/12/2002

ROBERT E. STRAUSS  
74527 Moss Rose Drive  
Palm Desert, CA 92260

EXAMINER

CHANG, VICTOR S

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 09/12/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/862,542

Applicant(s)

REEVES ET AL.

Examiner

Victor S Chang

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 9-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) ✓
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-8, drawn to a heat transfer label, classified in class 428, subclass 343.
  - II. Claims 9-15, drawn to a rotational molding method for incorporating indicia in the exterior surface of a molded part, classified in class 156, subclass 60+.

The inventions are distinct, each from the other because:

2. Inventions Group I, claims 1-8 and Group II, claims 9-15 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the transfer label can be used as a heat transfer label in a flat laminating mold.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Robert Strauss on 9/3/2002 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-8.

Affirmation of this election must be made by applicant in replying to this Office action.

Claims 9-15 are withdrawn from further consideration by the examiner, 37

CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 5, please insert --,-- before and after "in a preselected indication array".

In claim 1, line 9, delete "a top-coat,".

In claim 2, line 2, delete "a backing coat"; line 4, change ";" to --,--

In claims 3, 4, and 5, line 1 in each claim, insert --glass-- before "transition".

In claim 8, the phrase "said polyolefin" lacks antecedent basis.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-3, 6, and 8 are rejected under 35 U.S.C. 102(b) as anticipated by Markar et al. (US 5908694).

In FIG. 2, Markar teaches a heat-transfer label that is particularly well-suited for use on polyethylene surfaces, including high-density and low-density polyethylene containers. Label (111) comprises a support portion (113) and a transfer portion (121). Transfer portion (121) preferably includes a protective lacquer layer (123) directly on top of a portion of wax release layer (115), and an ink design layer (125) printed onto a desired area of lacquer layer (123). The heat-activatable adhesive layer (127) is coated over the design layer (125) and onto a surrounding portion of wax release layer (115). Markar also teaches that the protective lacquer layer (123) preferably comprises a hard polyester or acrylic resin, as well as an adhesion promoter for adhering layer (123) to layers (125), (127), and (115). Further, Markar explains that it is believed that, if transfer portion (121) is not fixed sufficiently to wax release layer (115), then a shrinkage or expansion of one or more of the constituent layers of transfer portion (121) occurs during the heating (i.e. drying) step could render the label unacceptable (column 10, lines 6-37). It is noted that although Markar calls layer (123) as a protective lacquer

layer, it functions the same as a heat-activatable pressure sensitive adhesive layer as instant claimed heat-activatable "backing-coat" pressure sensitive adhesive layer.

Claims lack novelty.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markar et al. (US 5908694).

The reference is again relied upon substantially as set forth above. For claims 1-3, 6 and 8, if, for the purpose of anticipation, the reference is believed to teach such a number of different embodiments that the specific parameters of each of the claims cannot be considered to be in possession of the skilled artisan, the Examiner believes that, alternatively, each of the claimed embodiments is at most a minor modification to one of ordinary skill. Note particularly that in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art to modify Marker's protective lacquer layer with a suitable heat-activatable pressure sensitive layer, motivated by the desire to improve the adhesion between the layers to alleviate shrinkage problems, as taught by Marker.

Note also that, with respect to claims 4, 5 and 7, Marker lacks specific teachings of the glass transition temperatures of the top-coat and backing-coat, and the composition of the indica coat.

For claim 4, Markar does teach that the protective lacquer layer (123) preferably comprises a hard polyester or acrylic resin, as well as an adhesion promoter for adhering layer, and shows a lacquer composition, in ALTERNATIVE No. 2, as a mixture of polyester resin (softening point of 275-297°F) and vinyl resin (glass transition temperature of 79°C, or 174°F) (column 7, lines 36-58). As such, in the absence of unexpected results, it is believed that a backing-coat with glass transition temperature greater than 170°F is either expressly or inherently disclosed, or an obvious optimization to one of ordinary skill, motivated by the desire to retain the integrity of the protective coating during labeling process.

For claim 5, it is believed that suitable heat-activatable pressure sensitive adhesive, such as a standardized polyamide-nitrocellulose or polyacrylic adhesive, for top-coat in a heat transfer label is well known to be applicable under 170°F processing temperature of rotational molding at labeling stage.

For claim 7, although Marker does not teach the composition of the indica coat, it is believed that it is conventional and well known that the ink used for indica coat in a heat transfer label is generally made of a mixture of hydrocarbon wax and colorant.

**12.** The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In addition, the following references are cited of interest for making heat transfer label:

US 4555436 to Geurtsen et al.

US 4529624 to Hubbard

US 5932319 to Makar et al.

US 5824176 to Stein et al.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

VSC  
September 10, 2002

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1800  
1700

*Daniel Zinker*